

Remarks/Arguments

Claims 1 - 20 are pending.

Objection to Claim 11 Under 37 C.F.R. §1.75(c)

Claim 11 stands objected to under 37 C.F.R. §1.75(c) as being in improper dependent form. Applicant has amended Claim 11, without prejudice, to depend from Claim 9. Accordingly, reconsideration and removal of this objection is respectfully requested.

Rejection of Claims 1, 12 and 20 Under 35 U.S.C. §103(a)

Claims 1, 12 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Park (United States Patent No. 5,689,559) in view of EBU ("Functional model of a conditional access system", EBU Project Group B/CA). Claims 2 – 10 and 13 - 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Park in view of EBU and further in view of Mandelbaum (United States Patent No. 5,544,246). Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Park, in view of EBU, in view of Mandelbaum, and further in view of Kuroda (United States Patent No. 5,815,472). Applicant respectfully traverses these rejections for at least the following reasons.

To establish a prima facie case of obviousness, all of the recited claim limitations must be taught or suggested in the prior art. *See, MPEP 2143.03; see also, In re. Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).* Further, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. *See, M.P.E.P. 706.02(j).* Further yet, the teaching or

suggestion to make the claimed combination must be found in the prior art, and not based on the applicant's own disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant respectfully submits the cited prior art references, singly and in combination, fail to teach or suggest all of the limitations of Claim 1.

More particularly, Claim 1 recites, in part:

A method for copying a program having a scrambled program content component and an encrypted control component comprising: ... (c) encrypting said encrypted control component and said data item to generate a nested control component.

Applicant respectfully submits that Park in view of EBU fails to teach or suggest at least encrypting said encrypted control component and data item to generate a nested control component.

For purposes of completeness, and by way of non-limiting example only, support for this limitation may be found in the present specification, on page 8, line 28 – page 9, line 2, wherein it teaches:

In one embodiment of the present invention if the content is scrambled, the recorder encrypts the ECMs using the global public key. Before encryption takes place, the recorder attaches a mark (or data item) (see Figure 2b) to each ECM as an indication of copying. In general, every time a scrambled movie is copied, its ECMs are encrypted once again, a process that may be referred to as "nesting". This allows the smartcard to determine how many times the original movie has been copied. The following example (wherein GPK is the Global public key, E is the Encryption process, CW is the Control word (the key for descrambling) and ECM contains CW, CCI, source of the content and other data) detects an illegitimate copy and prevents the display thereof.

Assume an ECM of the movie has the form: $E_{GPK}(CW, \text{never-copy})$. If a recorder receives this ECM. it will transform it to: $E_{GPK} [E_{GPK}(CW, \text{never-copy}), \text{copy-mark}]$.

The movie with this nested ECM will be the output of the recording process.

Applicant respectfully submits Park fails to teach or suggest at least the recited nesting of Claim 1. Instead, Park merely teaches, “when it is determined that the copy is permitted after analyzing the marker, the detected marker is updated to be encrypted by means of the encoded key and the result is inserted to the audio and video bit strips to be recorded 16, 17 and 18.” *See, Park, Col. 4, lines 59-63.*

In further evidence, Park also teaches, “the marker inserting step is performed by updating the marker when the copy is permitted after analyzing the marker 16, encrypting the updated marker by means of the encoded key 17, and replacing the encrypted marker with the following marker to be inserted 18.” *See, Park, Col. 6, lines 29-33 (emphasis added).* And, that “if the copy is permitted after analyzing the marker, the current generation of the current generational field is augmented by one to update the marker 16.” *See, Park, Col. 6, lines 34-40.*

Thus, Applicant respectfully submits that Park fails to teach at least the recited nested control component generated by further encrypting an already encrypted control component and a data item. Further, Applicant respectfully submits that the use of ECM in EBU also fails to teach or suggest the claimed nested control component of Claim 1.

Accordingly, as Park and EBU each fail to teach or suggest the recited “encrypting said encrypted control component and said data item to generate a nested control component” of Claim 1, clearly their combination also fails to teach or suggest such a feature. Wherefore Applicant respectfully requests reconsideration and removal of the rejection of Claim 1 for at least the foregoing reasons. Applicant also respectfully

requests reconsideration and removal of the rejections of Claims 2 – 11, at least by virtue of these Claims' ultimate dependency from a patentably distinct base Claim 1.

Applicant respectfully requests reconsideration and removal of the rejection of Claim 12 also, at least by virtue that Claim 12 analogously recites, "receiving said restricted program in a processing apparatus, said restricted program having a scrambled program content component and a nested control component." Applicant respectfully requests reconsideration and removal of the rejections of Claims 13 – 19 also, at least by virtue of these Claims' ultimate dependency from a patentably distinct base Claim 12.

Applicant also respectfully requests reconsideration and removal of the rejection of Claim 20, at least by virtue that Claim 20 analogously recites a "restricted program having a scrambled audio/video component and a nested control component."

CONCLUSION

Wherefore, Applicant believes he has addressed all outstanding grounds raised by the Examiner and respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited.

Should there be any questions or outstanding matters, the Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Edward J. Howard", written over a horizontal line.

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